

Remarks

Status of the Claims

Claims 125-149 are canceled herein as being drawn to nonelected subject matter. Applicants reserve the right to claim the subject matter of the canceled claims in continuing applications. Claim 113 is amended herein. Support for the amendments to claim 113 can be found, *inter alia*, in Example 1, Figures 2A-F, Figures 3A-F, and at page 7, lines 10-11 of the specification. Therefore no new matter is added. Claims 113-124 are pending in the application.

Rejection of the claims under 35 U.S.C. § 112, first paragraph

Claims 113-124 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. (Office action, page 2.) Applicants respectfully disagree.

The Examiner asserts that “[t]he specification does not provide support for **any nucleic acid molecule** comprising the generic elements recited in claim 113.” (Office Action, page 3.) While not agreeing with the Examiner’s assertion, Applicants have amended independent claim 113 to more clearly define the subject matter being claimed.

In particular, claim 113 has been amended to recite (1) an origin of replication which allows for replication in a prokaryotic cell, (2) a first positive selection and a second positive selection marker which allow for selection in a prokaryotic cell, and (3) that the first recombination site and the second recombination site do not recombine with each other. Applicants believe that these amendments clarify that the claims are not directed to “any” nucleic acid but to those that function in prokaryotic cells as described in Example 1 of the specification and so are fully described as required by 35 U.S.C. § 112, first paragraph.

Applicants note that, with respect to cDNA molecules, the Federal Circuit has stated that:

A description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. . . .

Univ. of California v. Eli Lilly & Co., 43 U.S.P.Q.2d 1398, 1406 (Fed. Cir. 1996).

Applicants further note that (1) the subject matter of claim 113, as amended herein, would be readily apparent to one of skilled in the art and (2) the subject matter of this claim can readily be found in the specification of the application. As an example, a nucleic acid molecule which falls within the scope of amended claim 113 is shown in Figure 4A. Also, positive selection markers which allow for selection in a prokaryotic cell are noted at page 14, line 26 through page 15, line 15 and page 35, lines 8-9 of the specification.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection based on 35 U.S.C. § 112, first paragraph.

Conclusion

All of the stated grounds of rejection have been properly traversed or otherwise overcome. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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